

REMARKS

Applicants submit this Request for Reconsideration After Final in reply to the Final Office Action mailed September 11, 2007. In the Final Office Action, the Examiner allowed claims 97, 105, 106, 112, and 115-127; rejected claims 80, 82, 84-96, 98-104, 107-111, and 113-114 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,788,224 to Platt ("Platt '224") in view of U.S. Patent Application No. 2005/0127346 to Steffes ("Steffes"); and rejected claim 83 under 35 U.S.C. § 103(a) as being unpatentable over Platt '224 in view of Steffes and further in view of U.S. Patent No. 6,698,726 to Platt ("Platt '726").

As an initial matter, Applicants gratefully acknowledge the Examiner's allowance of claims 97, 105, 106, 112, and 115-127. Applicants point out, however, an apparent discrepancy in the Final Office Action. On the Office Action Summary page, the Examiner indicates that claims 97, 105, 106, 112, and 115-127 are allowed. On page 7 of the Final Office Action, however, the Examiner indicates that "[c]laims 97, 105-106, 112, and 116-127 are allowed," omitting claim 115. Claim 115, however, is not rejected on any basis anywhere in the Final Office Action. Accordingly, for the purpose of responding to the Final Office Action, Applicants treat claim 115 as having been allowed by the examiner, as noted on the Office Action Summary page.

Claims 80 and 82-131 are currently pending in this application. Applicants point out that the Examiner withdrew claims 128-131 from consideration in the Final Office Action. Claims 80, 97, 105, 106, 115, and 128 are the sole independent claims.

Applicants respectfully traverse the Examiner's rejection of claims 80, 82, 84-96, 98-104, 107-111, and 113-114 under 35 U.S.C. § 103(a) as being unpatentable over

U.S. Patent No. 5,788,223 to Platt '224 in view of U.S. Patent Application No. 2005/0127346 to Steffes, detailed on pages 3-6 of the Final Office Action. Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness because the Examiner has not either (1) shown that all claimed elements were known in the prior art; (2) provided a suggestion or a motivation for one of ordinary skill in the art to modify the teachings of Platt '244, and Steffes, or (3) evidenced that the proposed combination of Platt '224 and Steffes would have a reasonable expectation of success. See M.P.E.P. §§ 2143 (A). Nor does it appear that the Examiner has properly considered all of the words in the pending claims. See M.P.E.P. §§ 2143.03. Claim 80 recites a rail assembly including, among other aspects, "wherein in the first configuration of the rail relative to the post, a longitudinal axis of the rail is at a first angle relative to the mounting surface of the post, and in the second configuration of the rail relative to the post, the longitudinal axis of the rail is at a second angle relative to the mounting surface of the post different from the first angle," wherein the "second configuration [is] different from the first configuration." Neither Platt '244 nor Steffes discloses at least this aspect of the invention either alone or in combination with the other aspects of the invention. The Examiner contends that Platt '244 teaches that "[t]he first configuration of the rail is configured to be mounted to the post at a first angle relative to the mounting surface of the post and in the second configuration of the rail is configured to be mounted at a second angle relative to the mounting surface of the post different from the first angle." (Office Action at 4.) Applicants disagree.

Platt '244 does disclose a "clip in which the locking bracket can be molded in various configurations to correspond to various styles of fence rails; and which is easily

installed by merely screwing the face to the fence post, inserting the end of the fence rail into the locking bracket and sliding the locking bracket over the base.” This disclosure refers to molding the locking bracket during manufacturing of the locking bracket, in order for the locking bracket of the Platt '244 invention to be used with different types of fence rails. Once manufactured, the locking bracket disclosed in Platt '244 can only be mounted to a fence rail in a single configuration. Platt '244 does not provide for a bracket having two different configurations for mounting to a single fence rail, as recited in claim 80.

More specifically, Platt '244 discloses a first configuration, in Figs. 1, 2, 9, and 15, where a longitudinal axis of fence rail 2 is at a first angle relative to a mounting surface of fence post 3, however, Platt '244 does not disclose a second configuration where the longitudinal axis of fence rail 2 is at a second angle different from the first angle relative to the mounting surface of fence post 3. Indeed, Platt '244 discloses only one configuration where fence rail 2 appears to be at a 90 degree angle relative to fence post 3. By contrast, Fig. 9 of the present application discloses examples of the first and second configurations (e.g., the configurations of rail 30 on the left and right sides of post 21) that meet the aforementioned aspects of claim 80. Accordingly, Platt '244 does not disclose the subject matter of independent claim 80.

Moreover, the Examiner has not provided support or explanation for the contention that Platt '244 discloses a bracket capable of mounting a rail in first and second configurations that are different from one another. Accordingly, Applicants respectfully ask the Examiner to provide such support and the explanation for this contention in any Advisory Action issued in response to this Request.

The Examiner further concedes that Platt '244 "fails to teach the horizontal width of the rail is greater than horizontal width of the bracket." (Office Action at 5.) The Examiner contends, however, that "Steffes teaches the rail (60 and 20) having horizontal width greater than the horizontal width of the bracket (40)." (Id.) Nevertheless, Steffes does not disclose or suggest "wherein in the first configuration of the rail relative to the post, a longitudinal axis of the rail is at a first angle relative to the mounting surface of the post, and in the second configuration of the rail relative to the post, the longitudinal axis of the rail is at a second angle relative to the mounting surface of the post different from the first angle," wherein the "second configuration [is] different from the first configuration," as recited in claim 80. Thus, Steffes fails to cure the above-mentioned deficiencies of Platt '244, in reference to independent claims 80.

Moreover, Applicants submit that Platt '244 teaches away from such a proposed combination with Steffes. If the rail of Platt '244 was modified to be wider in the horizontal direction than the bracket (6), it follows that the bracket (6) would have to be positioned within the end of the rail. Further, in order for the bracket (6) to properly mate with the base (4) attached to the post (3), the bracket (6) would have to extend beyond the end of the rail. As a result, a gap would form between the end of the rail and the post (3) when the bracket (6) was attached to base (4) on the post (3). Applicants submit that one skilled in the art would likely find such a gap undesirable. Based on this, Platt '244 teaches away from being combined with Steffes.

Thus, for at least the above reasons, claim 80 is allowable over Platt '244 in view of Steffes. Accordingly, claims 82, 84-96, 98-104, 107-111, and 113-114 are allowable at least due to their dependence from allowable claim 80 and due to their additional

recitations of novel subject matter. Applicants respectfully request withdrawal of the § 103(a) rejection based on Platt '244 in view of Steffes.

In addition, with respect to claim 111, which depends from claim 80, the Examiner contends that "Platt teaches the first and second angles but fails to specify the first angle is at 90 and second angle is at 45 degrees. It would have been obvious for one of ordinary skill . . . to have modified the angle of first and second surfaces to 90 and 45 degrees to provide designer's preference for the appearance of the bracket." (Office Action at 6.) Applicants respectfully disagree and submit that the Examiner has failed to provide a clear articulation of the reasons why one skilled in the art at the time of the invention would modify Platt '244 to make a railing assembly having a first configuration with a 90 degree rail to post angle and a second configuration having a 45 degree rail to post angle. For example, the Examiner provided any evidence suggesting that such a modification would have reasonably been successful to one skilled in the art. Accordingly, for at least this additional reason, claim 111 is allowable over the cited references.

Applicants respectfully traverse the Examiner's rejection of claim 83 under 35 U.S.C. § 103(a) as being unpatentable over Platt '224 in view of Steffes and further in view of Platt '726. Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness because the Examiner has not either (1) shown that all claimed elements were known in the prior art; (2) provided a suggestion or a motivation for one of ordinary skill in the art to modify the teachings of Platt '244, Steffes, and Platt '726 to make the claimed invention; or (3) evidenced that the proposed combination would have a reasonable expectation of success in so combining

and/or modifying their teachings. See M.P.E.P. §§ 2143 (A). The Examiner concedes that Platt '244 “fails to teach the rail is not in the substantially horizontal orientation.” (Office Action at 6.) The Examiner contends, however, that “Platt '726 teaches the rail (16) mounted to the post at an angle and not in the substantially horizontal orientation.” (Id.) Nevertheless, Platt '726 fails to cure the above-mentioned deficiencies of Platt '244 and Steffes, with respect to independent claim 80, from which claim 83 directly depends. Accordingly, claim 83 is allowable over the cited references.

In summary, each of claims 82-96, 98-104, 107-114, and 116-127 depends directly or indirectly from one of independent claims 80, 97, 105, 106, and 115, and each is therefore allowable for at least the same reasons that each of respective independent claims 80, 97, 105, 106, and 115 is allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the references and therefore each is also separately patentable.

In addition, Applicants respectfully traverse the Examiner's withdrawal of previously presented claims 128-131 as allegedly being drawn to a non-elected invention. The Examiner contends that claims 128-131 are directed to a combination that “does not require the particulars of the subcombination as claimed . . . [and that t]he subcombination has separate utility such as providing ornament appearance of rail by covering both edges thereof. Applicants disagree. Initially, Applicants submit that there would be no undue burden on the Examiner to conduct a search related to claims 128-131. Moreover, Applicants point out that the Examiner's contention that all of claims 80 and 82-127 are directed to a subcombination requiring covered edges is incorrect. For

example, allowed claim 97 clearly does not require a rail being covered at both edges thereof. Accordingly, the rationale supporting the restriction is incorrect.

Further, claim 128 recites similar limitations to those distinguished from the prior art in the discussion of claim 80 above. Applicants submit that claim 128 is allowable over the cited references for at least the same reason claim 80 is allowable and that an additional search is not required. Claims 129-131 are also allowable at least due to their dependence from allowable claim 128. For at least these reasons, Applicants respectfully ask the Examiner to reconsider the restriction and withdrawal of claims 128-131 and ask that these claims be allowed.

Applicants respectfully request that this Request for Reconsideration After Final under 37 C.F.R. § 1.116 be considered by the Examiner, placing the pending claims in condition for allowance. Applicants respectfully request withdrawal of the § 103(a) rejections and allowance of pending claims 80 and 82-131.

Applicants note that the Final Office Action contains several statements reflecting assertions about the pending claims and the cited references. Regardless of whether any such statement is addressed specifically above, Applicants decline to subscribe to any assertion in the Final Office Action.

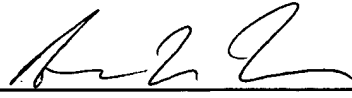
If a telephone interview will expedite issuance of this application, the Examiner is requested to call the undersigned at (202) 408-4387 to discuss any remaining issues.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 11, 2007

By: 
Aaron L. Parker
Reg. No. 50,785